

ESTTA Tracking number: **ESTTA210776**

Filing date: **05/12/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049105
Party	Defendant Safeway Inc.
Correspondence Address	Safeway Inc. 5918 Stoneridge Mall Road Pleasanton, CA 945882322 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Jordan S. Weinstein
Filer's e-mail	jweinstein@oblon.com, tmdocket@oblon.com
Signature	/jsw/
Date	05/12/2008
Attachments	325228US-motion.PDF (4 pages)(116582 bytes)

“Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.”

On February 1, 2008, Safeway filed a Petition for Cancellation of Eat Right Foods Limited (“ERFL”)’s Registration 3,045,314, and the Petition was assigned Cancellation No. 92/048847. In Safeway’s Petition for Cancellation, it alleges ownership of Application Serial Nos. 76/666,322 and 76/659,783, both for the marks EATING RIGHT & Design for a variety of foods and beverages; that the Examining Attorney issued final refusals to register in both Safeway applications under Section 2(d) of the Trademark Act, 15 USC §1052(d), based on ERFL’s Registration No. 3,045,314 for the mark EATRRIGHT & Design for organic and allergy sensitive cakes and cookies; and that, upon information and belief, Safeway is the prior user of the EATING RIGHT & Design marks. Safeway did not plead ownership of any registrations.¹

ERFL filed a Petition for Cancellation of Safeway’s Registration No. 3,395,214 for the mark EATING RIGHT for various food items on March 27, 2008, resulting in this Cancellation No. 92/049105. ERFL’s Petition is based on its allegations of ownership of Registration No. 3,045,314, that EFRL is the prior user of the EATRRIGHT & Design mark, and that there is a likelihood of confusion.²

Thus, the registration pleaded by ERFL as plaintiff in this cancellation proceeding is the subject of Safeway’s earlier filed Petition. The final determination of Safeway’s earlier Petition for Cancellation against EFRL’s Registration No. 3,045,314 will be dispositive of, or at the very least will have a significant bearing on, the issues before the Board in this cancellation

¹ Safeway filed Notices of Appeal of both final refusals in its pending applications. The Board has suspended the appeals pending the outcome of Safeway’s Petition for Cancellation against Registration No. 3,045,314. (Cancellation No. 92/048847.)

² Safeway filed its Answer to the Petition for Cancellation simultaneously with this Motion to Suspend.

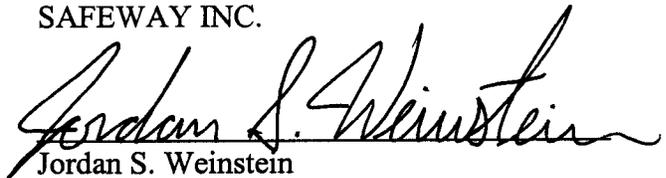
proceeding. The suspension of this case is appropriate under the Trademark Rules of Practice and will allow for the most economical disposition of the disputes between the parties relating to the involved marks. TBMP §§510.01 and 510.02(a)(Second Edition rev. 2004).

Safeway, as Respondent herein, respectfully requests that that the Board grant Respondent's Motion to Suspend, and order that all pending dates in this proceeding are suspended pending the final determination of Cancellation No. 92/048847.

Respectfully submitted,

SAFEWAY INC.

By:



Jordan S. Weinstein
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000
fax (703) 413-2220
e-mail: tmdocket@oblon.com

Date: May 12, 2008

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing RESPONDENT'S MOTION TO SUSPEND PURSUANT TO TRADEMARK RULE 2.117(a) was served on Petitioner, this 12th day of May, 2008, by sending same via e-mail and international airmail, postage prepaid, to:

Rebecca Douglas-Clifford
Eat Right Foods Limited
7 Kotua Place
P.O. Box 1525
Nelson, 7040 NEW ZEALAND